

## REMARKS

### **I. Status of the Claims**

Claims 1-54 were originally filed. Claims 55-64 were subsequently added. Claims 16-54 have been canceled. Upon entry of the present amendment, claim 56 is amended to cure improper dependency. Claim 64 is amended to improve clarity. New claims 65-67 are added. These new claims are fully supported by the specification, for instance, new claim 65 finds support in Example 2 on page 60, line 28, of the specification; new claim 66 finds support on page 52, lines 7-9; and new claim 67 finds support in Example 6 on page 67. No new matter is introduced.

### **II. Specification**

The specification has been amended to provide updated priority information and to delete embedded browser-executable code(s), which introduces no new matter.

### **III. Claim Rejections**

#### **A. 35 U.S.C. §112, Second Paragraph**

Claim 64 was rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness for reciting a composition "comprising a fusion polypeptide comprising BCG and an amino acid sequence of MTB72F (SEQ ID NO:12)." The Examiner questioned how a polypeptide could comprise BCG and SEQ ID NO:12. In response, this claim has been reworded to eliminate any ambiguity.

Claim 55 and its dependent claim 61 were rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness for depending from canceled claim 16. Claim 55 has been amended to depend from claim 6.

Claims 6 and its dependent claims were rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness for reciting "a polynucleotide that hybridizes under stringent conditions to the complement of a polynucleotide comprising the nucleotide sequence of MTB72F (SEQ ID NO:11)." The Examiner indicated that the open transitional language would allow unknown sequences to be included in the complement sequence and thus provide no

structural limitation of the polynucleotide sequence capable of hybridizing to the complement sequence. As amended, claim 6 now recites "a polynucleotide that hybridizes under stringent conditions to the complement of the nucleotide sequence of MTB72 (SEQ ID NO:11)."

Claims 63 was similarly rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness for reciting "a polynucleotide that hybridizes under stringent conditions to the complement of a polynucleotide comprising the nucleotide sequence of MTB72F (SEQ ID NO:11)." Following the present amendment, claim 63 now recites "a polynucleotide that hybridizes under stringent conditions to the complement of the nucleotide sequence of MTB72F (SEQ ID NO:11)."

Claims 7-15 were rejected for alleged indefiniteness due to their dependency from other rejected claims. As discussed above, all relevant claims have been amended to overcome the indefiniteness rejections, the rejection of claims 7-15 is thus also addressed.

Applicants respectfully request that the indefiniteness rejections of the above-named claims be withdrawn.

B. Double Patenting

The Examiner raised four provisional rejections under the judicially created doctrine of obviousness-type of double patenting: claims 1-5 were provisionally rejected as being allegedly unpatentable over claims 1-5 of copending Application No. 09/886,349; claims 1-5 were provisionally rejected as being allegedly unpatentable over claim 1 of copending Application No. 10/359,460; claims 1-4, 6, and 62 were provisionally rejected as being allegedly unpatentable over claims 1-4 and 6 of copending Application No. 09/886,349; and claims 1-4, 6, and 62 were provisionally rejected as being allegedly unpatentable over claim 1 of copending Application No. 10/359,460.

Applicants submit that the Examiner should withdraw the provisional double patenting rejections and allow the claims pending in the present application. According to the MPEP §822.01, "[i]f the 'provisional' double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and

permit the application to issue as a patent..." This is precisely the case in the present application, since the only other rejections, the indefiniteness rejections have been addressed as indicated above. On the other hand, the relevant claims in USSN 09/886,439 and 10/359,460 have not been allowed. Thus, Applicants respectfully request that the Examiner withdraw the provisional double patenting rejection and allow the pending claims in the present application to issue.

If, however, patents issue from USSN 09/886,439 and 10/359,460 prior to the allowance of the present application, Applicants will consider the possibility of filing a terminal disclaimer.

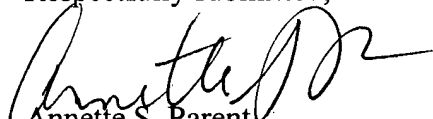
Claims 1-4, 6, and 62 were further rejected under judicially created doctrine of obviousness-type of double patenting as being allegedly unpatentable over claim 1 of U.S. Patent No. 6,544,522. Applicants will gladly consider filing a terminal disclaimer once the Examiner indicates that all pending claims are otherwise allowable.

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

  
Annette S. Parent  
Reg. No. 42,058

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 415-576-0200  
Fax: 415-576-0300  
ASP:cg  
60384171 v1